



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,647	07/31/2006	Rosanne M Crooke	ISPH-0595USA	5096

55389 7590 12/11/2006

KNOBBE, MARTENS, OLSON & BEAR, LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER

BOWMAN, AMY HUDSON

ART UNIT PAPER NUMBER

1635

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/559,647

Applicant(s)

CROOKE ET AL.

Examiner

Amy H. Bowman

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17, 26, 32, 33, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-11, 17, 26, 32, 33, 50 and 51 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1-11, 17 and 50, drawn to a compound targeted to a nucleic acid molecule encoding apolipoprotein(a), wherein the compound is at least 80% complementary to nucleotides 12380-13493 of SEQ ID NO: 4.

**Election of this group requires further election of a single sequence from claim 50, as explained below.**

- II. Claims 26, 32 and 33, drawn to a method of inhibiting the expression of apolipoprotein(a) and a method of treating an animal having a disease or condition associated with apolipoprotein(a) via introduction of the compound of claim 1. **Election of this group requires a further species election of a single disease or condition from claim 33, as explained below.**

This international searching authority considers that the international application does not comply with the requirements of unity of invention (Rules 13.1, 13.2, and 13.3) for the reasons indicated below:

Art Unit: 1635

According to the guidelines in Section (f)(i)(a) of Annex B of the PCT Administrative Instructions, the special technical feature as defined by PCT Rule 13.2 shall be considered to be met when all the alternatives of a Markush-group are of similar nature. For chemical alternatives, such as the claimed sequences, the Markush group shall be regarded as being of similar nature when

- (A) all alternatives have a common property or activity and
- (B)(1) a common structure is present, i.e., a significant structure is shared by all of the alternatives or
- (B)(2) in cases where the common structure cannot be the unifying criteria, all alternatives belong to an art-recognized class of compounds in the art to which the invention pertains.

The instant sequences are considered to be each separate inventions for the following reasons:

The sequences do not meet the criteria of (A), common property or activity or (B)(2), art recognized class of compounds. The sequences each behave in a different way in the context of the claimed invention. Each member of the class cannot be substituted, one for the other, with the expectation that the same intended result would be achieved.

Further, the sequences do not meet the criteria of (B)(1), as they do not share, one with another, a common core structure. Accordingly, unity of invention between the antisense sequences is lacking and each sequence claimed is considered to constitute a special technical feature.

Therefore, upon election of group I, applicant is required to elect one sequence from claim 50 for examination.

Additionally, each of the following diseases or conditions recited in instant claim 33 are each patentably distinct: a cardiovascular disease, atherosclerosis, hypercholesterolemia, coronary artery disease, or any specific combination thereof. Each of the species is independent or distinct because each has a unique etiology. A search for any one or combination of diseases or conditions would not necessarily return art for any of the other diseases or conditions.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

Art Unit: 1635

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy H. Bowman whose telephone number is (571) 272-0755.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Schultz can be reached on (571) 272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHB

  
JAMES SCHULTZ, PH.D.  
PRIMARY EXAMINER